



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,192	07/18/2003	Bruce M. Ruana	RUANA-001CIC	2668
28661	7590	08/26/2004	EXAMINER	
SIERRA PATENT GROUP, LTD. P O BOX 6149 STATELINE, NV 89449			MAYO, TARA L	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,192

Applicant(s)

RUANA, BRUCE M.

Examiner

Tara L. Mayo

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) 8,12-22,32-46,57-71,80-94 and 102-105 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,23-31,47-56,72-79 and 95-101 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2003/2003, 04 June 2004, 08 June 2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A of Figures 11 and 17 showing a grip including visual cues to which claims 12, 18, 19, 42, 43, 67, 68, 90, 91, and 102 through 105 are restricted;

Species B of Figure 13 showing a grip including light emitting means to which claims 3 through 7, 9 through 11, 27 through 31, 52 through 56, and 75 through 79 are restricted;

Species C of Figures 14 and 16 showing a grip including textured surfaces to which claims 8, 32 through 36, 57 through 61, and 80 through 84 are restricted;

Species D of Figure 15 showing a grip including sound emitting means to which claims 14 through 17, 38 through 41, 63 through 66, and 86 through 89 are restricted;

Species E of Figure 18 showing a grip including an antibacterial agent to which claims 20, 21, 44, 45, 69, 70, 92 and 93 are restricted;

Species F of Figure 19 showing a grip with an odorous element to which claims 22, 46, 71, and 94 are restricted; and

Species G disclosed on page 23 of the Specification in paragraph 0069 describing a grip including a flame retardant to which claims 13, 37, 62, and 85 are restricted.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 23 through 26, 47 through 51, 72 through 74, and 95 through 101 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Kenneth D'Alessandro on 18 August 2004 a provisional election was made without traverse to prosecute the invention of Species B of Figure 13, to which claims 3 through 7, 9 through 11, 27 through 31, 52 through 56, and 75 through 79 are restricted. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8, 12 through 22, 32 through 46, 57 through 71, 80 through 94 and 102 through 105 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it includes language that is implied. On line 2, delete "is disclosed." Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3671

6. Claims 9 through 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said textured material" on line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 10 and 11 are similarly rejected. Furthermore, the Examiner notes that as the claims appear to be directed to a non-elected species, they have not been considered for prosecution on the merits.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 24 through 26, 48 through 51, 73, 74, 96 through 101 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobe et al. (U.S. Patent No. 6,610,382 B1).

Kobe et al. '382, as seen in Figures 1 and 8, disclose a grip (20) for a grab bar having an outer surface, the grip comprising:

with regard to claims 1, 25, 48, 96 and 97,

a body (21) having a first side (24) and a second side (25);

Art Unit: 3671

a stretchable material (22; col. 4, lines 16 through 17 and 25 through 41) having a top surface and a bottom surface opposite said top surface, said top surface adhered to said second side of said body;

a releasable adhesive (34; col. 4, lines 54 through 56) disposed on said bottom surface of said stretchable material, said releasable adhesive configured to adhere to the outer surface; with regard to claim 2,

wherein said body comprises a distance between said first side and said second side, said distance being variable; with regard to claims 24 and 49,

wherein the grip substantially covers the outer surface; and with regard to claim 26,

wherein said body comprises a distance between said first side and said second side, said distance being variable.

With regard to claims 50, 51, 73, 74 and 98 through 101, the method steps recited therein are inherent to the method of making the device shown by Kobe et al. '382.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

Art Unit: 3671

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 3, 4, 7, 27, 28, 31, 52, 53, 56, 75, 76 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Oseroff et al. (U.S. Patent No. 3,848,480).

Kobe et al. '382 disclose all of the features of the claimed invention with the exception(s):

with regard to claims 3, 27, 52 and 75,

a light emitter coupled with the first side of the body;

with regard to claims 4, 28, 53 and 76,

the light emitter being a material selected from the group consisting of phosphorescent chemicals, low grade radiant materials, electrically stimulated phosphorescent material, reflective materials, and luminescent pigments;

with regard to claims 7, 31, 56 and 79,

the light emitter being activated in the absence of light.

Oseroff et al. '480, as seen in Figures 1 through 6, disclose a grip for a grab bar comprising a phosphorescent material (col. 5, lines 35 through 42) to serve as a luminous safety feature in the dark.

With regard to claims 3, 4, 7, 27, 28 and 31, it would have been obvious to one having ordinary skill in the art of grips at the time of invention to modify the grip disclosed by Kobe

Art Unit: 3671

et al. '382 with a phosphorescent material as taught by Oseroff et al. '480. The motivation would have been to provide a luminous safety feature.

With regard to claims 52, 53, 56, 75, 76 and 79, the method steps recited therein are inherent to the method of making the device shown by Kobe et al. '382 as modified above by Oseroff et al. '480.

11. Claims 3, 5, 27, 29, 52, 54, 75 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of McCalla et al. (U.S. Patent No. 6,364,500 B1).

Kobe et al. '382 disclose all of the features of the claimed invention with the exception(s):

with regard to claims 3, 27 and 75,

a light emitter coupled with the first side of the body; and

with regard to claims 5, 29 and 77,

the light emitter being selected from the group consisting of fiber optics and light emitting diodes.

McCalla et al. '500, as seen in Figure 6, show a handle member (20) comprising fiber optics for directing light through the handle member (col. 3, lines 13 through 26).

With regard to claims 3, 5, 27 and 29, it would have been obvious to one having ordinary skill in the art of grips at the time of invention to modify the device shown by Kobe et al. '382 such that it would include fiber optics as taught to be desirable by McCalla et al. '500. The motivation would have been to illuminate the body of the grip.

With regard to claims 52, 54, 75 and 77, the method steps recited therein are inherent to the method of making the device shown by Kobe et al. '382 as modified above McCalla et al. '500.

12. Claims 3, 6, 27, 30, 52, 55, 75 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Bixler et al. (U.S. Patent No. 5,251,903).

Kobe et al. '382 disclose all of the features of the claimed invention with the exception(s) of:

with regard to claims 3, 27 and 75,

a light emitter coupled with the first side of the body; and

with regard to claims 6, 30 and 78,

the light emitter being configured to activate responsive to pressure.

Bixler et al. '903, as seen in Figures 1 through 4, show a ball (10) comprising a body cover (12) having an illumination means (col. 3, lines 23 through 26) which is activated by pressure for warning of an improper grip.

With regard to claims 3, 6, 27 and 30, it would have been obvious to one having ordinary skill in the art of grips at the time of invention to modify the device shown by Kobe et al. '382 such that it would include a pressure activated light emitter as taught by Bixler et al. '903. The motivation would have been to provide the grip with a means for indicating contact with a user's hand as desired.

With regard to claims 52, 55, 75 and 78, the method steps recited therein are inherent to the method of making the device shown by Kobe et al. '382 as modified above by Bixler et al. '903.

13. Claims 23, 47, 72 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1).

Kobe et al. '382, as seen in Figures 1 and 8, disclose all of the features and method steps of the claimed invention with the exception(s) of:

with regard to claims 23, 47 and 72,

a backing layer adhered between the body and the releasable adhesive.

Kobe et al. '382 expressly teach the possibility of multiple backing layers (col. 2, lines 39 through 42, and col. 4, lines 5 through 8).

With regard to claim 23, it would have been obvious to one having ordinary skill in the art of grips at the time the invention was made to include a backing layer to impart desired strength to the skin layer of the device.

With regard to claims 47, 72 and 95, the method steps recited therein are inherent to the method of making the device disclosed by Kobe et al. '382 as modified above.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1, 2, 3, 4, 5, 23, 24, 25, 26, 27, 28, 29, 47, 48 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 9, 14, 15, 18, 39, 9, 10, 9, 14, 15, 18, 9 and 39 of copending Application No. 10/145,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because

With regard to claims 3 and 27, the term “coupled” recited therein is anticipated by the term “integral” recited in claim 9 of the ‘566 application.

With regard to claims 4 and 28, the term “light emitter” is encompassed within the scope of the term “light emitting means” recited in claim 14 of the ‘566 application.

With further regard to claims 4 and 28, the ‘566 application discloses the claimed invention except for a light emitter in the form of reflective materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute reflective materials for the claimed phosphorescent chemicals since the Examiner takes Official Notice of the equivalence reflective materials and phosphorescent chemicals for their use in the indicator art and the selection of any of these known equivalents to emit light would be within the level of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 703-305-3019. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TLM
22 August 2004



Thomas B. Will
Supervisory Patent Examiner
Group 3600